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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,584

11/26/2003

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EXAMINER

YOO, JASSON H

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

01/24/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/723,584

Applicant(s)

HOSAKA, TOSHIYUKI

Examiner

Jasson H. Yoo

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/29/07</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/29/07 has been entered.

### ***Information Disclosure Statement***

The Information Disclosure Statement submitted on 10/29/07 has been considered.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kodachi et al. (US 6,142,875) in view of Okada et al (US 2002/0155891).

Claim 1. Kodachi discloses a method and a gaming machine that displays a plurality of symbols to form a symbol combination. The gaming machine also displays a graphical image this is dependent upon the displayed symbols (see abstract). More specifically, Kodachi discloses a pachinko game machine (col. 1:13-14) that displays a plurality of varying numbers (cols. 5:16-20, 13:21-31, Fig. 11) to provide a win combination ("big hit", col. 1:22-37). During the reach state of the game, the game machine displays a number and a graphical image (cols. 1:38-49, 2:19-31, 2:48-55, 3:26-31, 3:65-4:54, Figs. 5-6, 7, 24-25). Kodachi discloses a plurality of reach states. Each state occurs when by displaying a number (2L, 2C, 2R in Fig. 2) and a picture (K in Fig. 2). Kodachi discloses various time configurations can be used to provide the different reach-states (Figs. 15-23, 28). For example, Fig. 20 shows how during the first-reach state, a first numeral image (left symbol) and a first image (face prognostic 1) are displayed. During the second-reach state, a second numeral image (right symbol) and second image (face prognostic 2) are displayed. A win state is reached if the game machine displays a number that corresponds to a win combination (2L, 2C, and 2R in Figs. 26-27). During the win-state, a graphical image is displayed along with the displayed number to indicate a "big hit" (Figs. 6-7, 26-27). Thus the win display image displays an image of a "big hit" and a third numeral image (center symbol according to embodiment of Fig. 20). If the displayed number does not correspond to a win combination (the non-winning number combination, or the "fourth numeral image"), the game results in a no win state, and does not display a big hit image (col. 14:8-17, Fig. 13). The graphical image is displayed separately at different location son the display

Art Unit: 3714

portion of the game machine (Figs. 24-27). When the game reaches the second reach-state, the second image allows a user of the game machine to forecast the win state based on the display second image (player can predict a "big hit", see abstract and cols. 2-6). Kodachi discloses the claimed invention but fails to specifically teach the images are advertising images. Nevertheless, it is well known in the art to use advertising images in gaming devices. In an analogous art to gaming devices that displays images and symbol combinations, Okada discloses a gaming machine that discloses advertising images. Okada discloses advertisements (13 in Fig. 15) are based on the symbol patterns of the game and are displayed separately at different locations on the display portion of the game machine (Fig. 15). Providing advertising images allows third parties such gaming sponsors to advertise their products and services. Therefore it would have been obvious to one of ordinary skilled at the time the invention was made to modify Kodachi's gaming device and incorporate Okada's advertising images in order to advertise the products and services of the game sponsors.

Claim 2. Kodachi in view of Okada discloses the advertising images have at least one advertisement contents and display features different from each other (Kodachi, Figs. 3, 8-9, 12-13, 24-27, 29-35, 52; Okada, Fig. 4).

Claim 3. Kodachi in view of Okada discloses the advertising image is contained in the display image based on advertising image data obtained through a

Art Unit: 3714

communication network to display the advertising image on the display portion (Okada, Fig. 4).

Claim 4. Kodachi discloses a display control device to perform the method of claim 1 as shown in Fig. 4. More specifically, Kodachi discloses the control device of the gaming machine comprising a ROM 50c to store information corresponding to the display symbols and display images. It is well known in the art that a single memory is composed of memory cells, which correspond to any number of memories. Furthermore, Okada discloses separate and distinct memory in a network environment; the first memory for storing production pattern data concerning a production pattern of a display image (game info database 2d in Figs. 2 and 3, and paragraph 69-70), the second memory for storing display image data concerning the display image (distribution in database 2f in Fig. 2 provides information to be displayed at the terminal 6, paragraphs 74, 98), and the third memory for storing advertising image data concerning advertising images (2i or 2e in Figs. 2 or ad server 3 in Figs. 1-2).

Claim 5, Kodachi in view of Okada discloses the third memory section stores the advertising image data concerning advertising images having at least one of advertisement contents and display features different from each other (As discussed above, Kodachi discloses a memory cell to store images that are different from each other. Okada teaches advertisement information consist of image information such as characters, figures and pictures, paragraph 72), and

The controller reads the advertising image data corresponding to the result of a lot drawing from the third memory section to display the advertising images on the display device of the game machine by containing the advertising images in the display image based on the advertising image data (Kodachi, col. 10:26-33, Okatada, paragraphs 99-103 and Figs. 1-2).

Claim 6. Kodachi in view of Okada discloses a receiver for receiving the advertising image data through a communication network, wherein the controller stores data received by the receiver in the third memory as the advertising image data concerning advertising images (Okada, 2a and 2b in Fig. 2).

### ***Response to Arguments***

Applicant's arguments filed 10/29/07 have been fully considered but they are not persuasive.

Applicant argues that Kodachi or Okada individually fails to teach the added claim limitations of a gaming machine having a first and second reach states, with the second win sated preceding a win state of the game machine. Applicant further argues that the second reach sate display image includes a second advertising image such that Kodachi or Okada individually fails displaying the second advertising image when the game machine is in the second reach-state allows a user of the game machine to forecast the win state based on the display of the second advertising image. However each newly added claim limitations has been addressed in the rejection above. It is

also noted that the rejection is based on Kodachi in view of Okada and on the references individually. In this case Kodachi teaches various time configurations can be used to provide the different reach-states (Figs. 15-23, 28). For example, Fig. 20 shows how during the first-reach state, a first numeral image (left symbol) and a first image (face prognostic 1) are displayed. During the second-reach state, a second numeral image (right symbol) and second image (face prognostic 2) are displayed. A win state is reached if the game machine displays a number that corresponds to a win combination (2L, 2C, and 2R in Figs. 26-27). During the win-state, a graphical image is displayed along with the displayed number to indicate a "big hit" (Figs. 6-7, 26-27). Thus the win display image displays an image of a "big hit" and a third numeral image (center symbol according to embodiment of Fig. 20). If the displayed number does not correspond to a win combination (the non-winning number combination, or the "fourth numeral image"), the game results in a no win state, and does not display a big hit image (col. 14:8-17, Fig. 13). The graphical image is displayed separately at different location son the display portion of the game machine (Figs. 24-27). When the game reaches the second reach-state, the second image allows a user of the game machine to forecast the win state based on the display second image (player can predict a "big hit", see abstract and cols. 2-6). Kodachi discloses the claimed invention but fails to specifically teach the images are advertising images. Nevertheless, it is well known in the art to use advertising images in gaming devices. In an analogous art to gaming devices that displays images and symbol combinations, Okada discloses a gaming machine that discloses advertising images. Okada discloses advertisements (13 in Fig. 15) are



Art Unit: 3714

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### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jasson H. Yoo whose telephone number is (571)272-5563. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571)272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3714

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JHY

A handwritten signature in black ink, appearing to read 'Xuan M. Thai', is positioned above the printed name and title.

**XUAN M. THAI**  
**SUPERVISORY PATENT EXAMINER**